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EXAMINER

FISCHER, ANDREW J

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 07/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicant(s)

09/587,201

Applicant(s)

LIBERMAN, BARNET L.

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) 48-62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 05 June 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election of Group I (claims 1-47) in Paper No. 6 is acknowledged. Because Applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 48-62 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 6.

### ***Election of Species***

3. Applicant's election with traverse of Species A in Paper No. 6 is acknowledged. The traversal is on the ground(s) that "none of the species A, B, or C can be considered a species of the invention claim in Claims 1-47, which recite methods.
4. First, whether or not Applicant's claims are directed towards methods or products is not determinative in species analysis.
5. Next, the original specification on page 15, lines 18-21, expressly states: "Alternatively, instead of having a zipper 293 on bag 280, a bag 280' made of mesh may be used to secure tote 200 (FIGS. 8A-C)." Because of this passage and after viewing Figure 8A, it is the Examiner's factual determination that Figure 8A represents a mutually exclusive embodiment different from the embodiment shown in Figure 5A. In other words, 280' is a different embodiment from 280.

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6. However, after further review of Applicant's specification and the prior art, the Examiner finds that the disclosed embodiments are not patentably distinct from one another. Because the various embodiments are not patentably distinct, the Election of Species as stated in Paper No. 5 is hereby withdrawn. If Applicant argues features of the embodiment separately, the Examiner will reconsider his position regarding the patentably distinct embodiments in light of Applicant's argument.

***Information Disclosure Statement***

7. The information disclosure statement ("IDS") filed November 15, 2000 (Paper No. 4) fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP §609 because Applicant has not provided the date of publication. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP §609 C(1).

8. The Examiner has considered the dates listed in Applicant's submitted PTO Form 149 (Paper No. 4) as the dates of publication.

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### *Specification*

9. The disclosure is objected to because of Applicant's statements that "none of Species A, B, or C can be considered species of the invention claimed."<sup>1</sup> The Examiner will presume (for Applicant's benefit) that Applicant intends the phrase to mean in reference to the chosen invention, not all claims. Second, Applicant's original specification expressly states on page 7, "FIG. 8A is a top view of an *alternative bag* used as a means for securing the tote within the grocery box . . . . [Emphasis added.]" In Applicant's election of species argument, he argues that the figures are not alternatives "all of which can be used in the inventive method claimed by the elected claims." Therefore, is at least Figure 8 an alternative or not? Appropriate correction is required.

### *Drawings*

10. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. No new matter allowed. The following must be shown or the features canceled from the claim(s):

- a. "[D]ispatching the first vehicle" as recited in claim 1.
- b. "[T]ransferring the rack with the tote thereon from the first vehicle to a second vehicle" as recited in claim 2.

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<sup>1</sup> See Applicant's "Remarks," Paper No. 6, Page 2.

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c. “[W]herein the second vehicle being smaller in size than the first vehicle” as recited in claim 3.

11. The Examiner notes the claims are replete with the above drawing errors. For example, the Examiner has located 3 drawing errors in the first 3 claims. It is also clear that all method steps recited in claim 2-47 are clearly not shown in the drawings. The Examiner notes that this application contains only *a single flowchart* for all 47 claims. The Examiner *highly recommends* Applicant review all 47 claims to ensure that every method step claimed is shown in the drawings (and preferably in flow chart form). To show no new matter is found in the drawings, the Examiner respectfully requests Applicants to explicitly show where in the specification Applicant has support or antecedent basis for any new drawings or drawing changes. Additionally, a proposed drawing correction or corrected drawings are required in reply to this Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112 1<sup>st</sup> Paragraph***

12. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

13. Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to

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which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicant has not disclosed how one of ordinary skill in the art would maintain a desired temperature by feeding a chilled gas into at least a portion of the tote.

14. If Applicant expressly admits on the record that such procedures are old and well known in the art and provides appropriate evidence in support thereof (i.e. a U.S. Patent), this particular rejection will be withdrawn.

***Claim Rejections - 35 USC § 112***

15. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

16. Claims 6, 7, 11, 15, 26, 37, and 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with errors. Some examples follow.

a. In claim 6, the phrases “early evening” and “early morning” are indefinite. For example, is 7 PM early evening? Is 8 PM, 9 PM, or 10 PM early evening? “If the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. 112, second paragraph would be appropriate.” MPEP §2173.02 citing *Morton Int’l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1470, 28 USPQ2d 1190, 1195 (Fed. Cir. 1993). In this case,

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one of ordinary skill in the art would not be able to ascertain which particular time is determinative of early evening.

b. In claims 7, 26, and 37, the phrase “6 hour radius” is indefinite. Is the 6 hours measured with a delivery truck, airplane, bicycle, or walking with a hand truck?

c. Claim 11 recites the limitation “the first lock” in line 2. There is insufficient antecedent basis for this limitation in the claim.

d. In claim 15, it is unknown what objects are needed to perform the claimed step of “feeding a chilled gas into at least a portion of the tote . . . .”

e. Claim 47 is indefinite since it states “storing the tote within a mesh before placing the tote into the box. “[S]emantic indefiniteness of claims is not rendered unobjectionable merely because it *could* have been corrected. [Emphasis in original.]” *Allen Engineering Corp. v. Bartell Industries Inc.*, 299 F.3d 1336, 1349, 63 USPQ2d 1769, 1776 (Fed. Cir. 2002) (citations and quotations omitted).

### ***Claim Rejections - 35 USC § 102***

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.



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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

18. Claims 1-3, 6, 7, 13, 30-34, and 43, as understood by the Examiner, are rejected under 35 U.S.C. 102(b) as being anticipated by Wilson et. al. (U.S. 2,589,768)("Wilson"). Wilson discloses placing a grocery item (bread) order by a customer in a tote (bread bag, inherent); placing the tote onto a removable rack in a warehouse (at the bakery); transferring the rack with the tote therein into a first vehicle (10); and dispatching the first vehicle to deliver the grocery item.

19. Claims 46 and 47, as understood by the Examiner, are rejected under 35 U.S.C. 102(b) as being anticipated Sone (U.S. 6,204,763). Sone discloses placing a delivery item within a tote (a bag), placing the grocery item within a box.

20. Claims 1, 8-13, 46, and 47, as understood by the Examiner, are rejected under 35 U.S.C. 102(b) as being anticipated by Lipowsky et. al. (U.S. 2,159,279)("Lipowsky"). Lipowsky discloses placing a grocery item (bread) order by a customer in a tote (bread bag); placing the tote onto a removable rack in a warehouse (at the bakery); transferring the rack with the tote therein into a first vehicle (inherent in the delivery vehicle); dispatching the first vehicle to deliver the

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grocery item; placing the tote in a secure expandable bag (15) which is attached to a box or other device (inherent); an insulated bag the (inner bag); and the ordered grocery item requires refrigeration, and maintaining the grocery item at a desired chilled temperature (inherent in maintaining the bag at the ambient temperature).

***Claim Rejections - 35 USC § 103***

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claims 1-3, 6, 7, 13, 30-34, and 43, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson.<sup>2</sup> It is the Examiner's principle position that the claims are anticipated because of the inherent features in Wilson as noted above. However if not inherent, the Examiner takes Official Notice that objects are delivered to customers with more than one vehicle or carrier and that the second vehicle or carrier may be smaller than the first vehicle or carrier. The Examiner also takes Official Notice that telephone are used to order goods.

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<sup>2</sup> See MPEP §2113, subsection titled "The Use of 35 U.S.C. 102/103 Rejections for Product-by-process Claims Has Been Approved by the Courts."

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wilson to include the second vehicle or carrier being smaller so that the smaller vehicle or carrier could travel in smaller places such as narrow streets. If Wilson's truck would not be able to drive down particular road, in particular tunnels, or travel over particular bridges, the goods must then be transferred to a smaller delivery vehicle.

23. Claims 46 and 47, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Sone. It is the Examiner's principle position that the claims are anticipated because of the inherent features in Sone as noted above. However if not inherent, the Examiner takes Official Notice that bags (totes) are used to transport articles and delivery groceries. Moreover, the Examiner takes Official Notice that mesh bags are used to deliver and store articles.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Sone to include placing the bag within a box (12). Such a modification would have helped prevent particular items from spilling inside the box.

24. Claims 1-13, 15-23, 25-43, and 45, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Sone in view of Lipowsky. Sone discloses dispatching a vehicle to deliver a grocery item; a customer ordering a grocery item by means of the Internet wherein the order is accepted before a cutoff time; the order is filled; establishing a warehouse where grocery items are stored (inherent); a plurality of warehouses within a 6 hour radius from a plurality of delivery destinations (inherent since multiple vendors are disclosed and each vendor

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typically has their own warehouse); a box (12) situated outside the delivery destination (the home); maintaining the grocery item (e.g. milk) at approximately a desired chilled temperature.

Sone does not directly disclose a bag to store the delivered bread. Lipowsky teaches storing the bread in the described bag. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wilson as taught by Lipowsky and include Lipowsky's storage bag. Such a modification would have helped prevent the bread or goods from becoming wet and moldy.

25. Claims 14, 24, and 44, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Sone in view of Lipowsky. The Sone/Lipowsky combination discloses as discussed above but does not directly disclose frozen inserts. The Examiner takes Official Notice that frozen inserts are used to keep foods cold.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Sone/Lipowsky combination to include placing frozen inserts within Lipowsky's bag. Such a modification would have helped keep the foods cold that where unable to fit in Sone's cabinet (and were therefore placed in Lipowsky's bag at the delivery destination).

26. Claims 1-47, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Peapod website ("Peapod I") in view of Sone and in further view of Lipowsky. Peapod I directly discloses the claimed methods including ordering and

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delivery groceries within a specific time using the Internet. Peapod I does not disclose a bag and a cabinet for storing the items at the delivery location.

Sone teaches a cabinet (cabinet 12 and other features as noted above) while Lipowsky teaches a bag (bag 24 and other features as noted above). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Peapod I as taught by Sone and Lipowsky to include a bag and cabinet for storing the items at the delivery location. Such a modification would have helped prevent the items from being stolen at the place of delivery.

27. Functional recitation(s) using the word “for” or “to” (e.g. “to maintain the grocery item at approximately a desired temperature” as recited in claim 15) have been given less patentable weight<sup>3</sup> because they fail to add any steps and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.).

28. It is the Examiner’s factual determination that all limitations in claims 1-47 have been considered and are either disclosed or inherent in the references as discussed above. Furthermore,

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<sup>3</sup> See e.g. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight.).

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the inherent features are established by a preponderance of the evidence. *In re Epstein*, 32 F.3d 1559, 1564, 31 USPQ2d 1817, 1820 (Fed. Cir. 1994) (“Preponderance of the evidence is the standard that must be met by the PTO in making rejections.” (citations and quotations omitted)). The preceding discussion in this paragraph regarding the standard for claim rejections applies to all examined claims currently pending.

29. After careful review of the specification and prosecution history, the Examiner is unaware of any desire—either expressly or implicitly—by Applicant to be his own lexicographer and to define a claim term to have a meaning other than its ordinary and accustom meaning. Therefore, the Examiner starts with the presumption that all claim limitations are given their ordinary and accustom meaning. See *Bell Atlantic Network Services Inc. v. Covad Communications Group Inc.*, 262 F.3d 1258, 1268, 59 USPQ2d 1865, 1870 (Fed. Cir. 2001) (“[T]here is a heavy presumption in favor of the ordinary meaning of claim language as understood by one of ordinary skill in the art.”); *CCS Fitness Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366, 62 USPQ2d 1658, 1662 (Fed. Cir. 2002) (There is a “heavy presumption that a claim term carries its ordinary and customary meaning.”). See also MPEP §2111.01 and *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).<sup>4</sup>

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<sup>4</sup> It is the Examiner’s position that “plain meaning” and “ordinary and accustom meaning” are synonymous. See e.g. *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001) (“[A]ll terms in a patent claim are to be given their plain, ordinary and accustomed meaning . . .”).

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In accordance with the ordinary and accustom meaning presumption, during examination the claims are interpreted with their “broadest reasonable interpretation . . . .” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).<sup>5</sup>

However, if Applicant disagrees<sup>6</sup> with the Examiner and has either (a) already used lexicography or (b) wishes to use lexicography and therefore (under either (a) or (b)) desires a claim limitation to have a meaning other than its ordinary and accustom meaning, the Examiner respectfully requests Applicant in his next response to expressly indicate<sup>7</sup> the claim limitation at issue<sup>8</sup> and to show where in the specification or prosecution history the limitation is defined. Such definitions must be clearly stated in the specification or file history. *Bell Atlantic*, 262 F.3d at 1268, 59 USPQ2d at 1870, (“[I]n redefining the meaning of particular claim terms away from

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<sup>5</sup> See also MPEP §2111; *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

<sup>6</sup> See 37 CFR § 1.111(b).

<sup>7</sup> “Absent an *express intent* to impart a novel meaning, terms in a claim are to be given their ordinary and accustomed meaning. [Emphasis added.]” *Wenger Manufacturing Inc. v. Coating Mach. Sys., Inc.*, 239 F.3d 1225, 1232, 57 USPQ2d 1679, 1684 (Fed. Cir. 2001) (citations and quotations omitted). “In the absence of an *express intent* to impart a novel meaning to claim terms, an inventor’s claim terms take on their ordinary meaning. We indulge a heavy presumption that a claim term carries its ordinary and customary meaning. [Emphasis added.]” *Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1325, 63 USPQ2d 1374, 1380 (Fed. Cir. 2002) (citations and quotations omitted).

<sup>8</sup> “In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent’s scope must, at the very least, point to a term or terms in the claim with which to draw in those statements.” *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

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the ordinary meaning, the intrinsic evidence must ‘clearly set forth’ or ‘clearly redefine’ a claim term so as to put one reasonably skilled in the art on notice that the patentee intended to so redefine the claim term”).<sup>9</sup> The Examiner cautions that no new matter is allowed.

Failure by Applicant in his next response to address this issue or to be non-responsive to this issue entirely will be considered a desire by Applicant to forgo lexicography in this application and to continue having the claims interpreted with their ordinary and accustomed meaning and with their broadest reasonable interpretation. Additionally, it is the Examiner’s position that above requirements are reasonable.<sup>10</sup> Applicant is also cautioned that even though claim interpretation begins with this presumption, after issuance the prosecution history may further limit claim scope if Applicant disclaims or disavows a particular interpretation of the claims during prosecution.

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<sup>9</sup> See also *Vitronics Corp. v. Conceptor, Inc.*, 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1576 (Fed. Cir. 1996), (“[A] patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, *as long as* the special definition of the term is *clearly stated* in the patent specification or file history. [Emphasis added.]”); *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998) (“Such special meaning, however, must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.”). See also MPEP §2111.01, subsection titled “Applicant May Be Own Lexicographer” and MPEP §2173.05(a) titled “New Terminology.”

<sup>10</sup> The requirements are reasonable on at least two separate and independent grounds. First, the Examiner’s requirements are simply an express request for clarification of how Applicant intends his claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicant is not inadvertently overlooked by the Examiner. Second, the requirements are reasonable in view of the USPTO’s goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO’s The 21<sup>st</sup> Century Strategic Plan, February 3, 2003 available at [www.uspto.gov/web/offices/com/strat21/index.htm](http://www.uspto.gov/web/offices/com/strat21/index.htm) (last accessed July 1, 2003).



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*Abbott Laboratories v. TorPharm Inc.*, 300 F.3d 1367, 1372, 63 USPQ2d 1929, 1931 (Fed. Cir. 2002). Unless expressly noted otherwise by the Examiner, the preceding discussion on claim interpretation principles applies to all examined claims currently pending.

30. Under the broadest reasonable interpretation standard noted above, the Examiner hereby adopts the following definitions as the broadest reasonable interpretation in all his claim interpretations:

a. **Server**: “2. On the Internet or other network, a computer or program that responds to commands from a client.” Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997.<sup>11</sup> **Client**: “3. On a local area network or Internet, a computer that accesses shared network resources provided by another computer (called a *server*).” *Id.* **Computer**: “Any machine that does three things: accepts structured input, processes it according to prescribed rules, and produces the results as output.” *Id.*

31. Additionally, the Examiner notes that “the PTO and the CCPA acknowledged product-by-process claims as an exception to the general rule requiring claims to define products in terms of structural characteristics.” *Atlantic Thermoplastics Co. v. Faytex Corp.*, 970 F.2d 834, 845, 23 USPQ2d 1481, 1490 (Fed. Cir. 1992) (hereinafter “*Atlantic Thermoplastics v.*

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<sup>11</sup> It is the Examiner’s position that the *Microsoft Press Computer Dictionary* is an appropriate technical dictionary known to be used by one of ordinary skill in this art. See e.g. *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1373, 65 USPQ2d 1865, 1872 (Fed. Cir. 2003) where the Federal Circuit used *Microsoft Press Computer Dictionary* (3d ed.) as “a technical dictionary” used to define the term “flag.”

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*Faytex I*"). Furthermore, the Federal Circuit "acknowledges that it has in effect recognized . . . product-by-process claims as exceptional." 970 F.2d at 847, 23 USPQ2d at 1491.

Because of this exceptional status, the Examiner has carefully reviewed claims 1-47 and finds that the claims *do not* contain any product-by-process limitations whether in a conventional format or otherwise. If Applicant disagrees with the Examiner, the Examiner respectfully requests Applicant in his next response to expressly point out any product-by-process claim(s) and their limitations so that they may be afforded their exceptional status and treated accordingly.

Applicant is reminded that "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself." *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted).<sup>12</sup> Failure by Applicant in his next response to also address this issue or to be non-responsive to this issue entirely will be considered intent by Applicant *not* to recite any product-by-process limitations. Unless expressly noted otherwise by the Examiner, the preceding discussion on product-by-process principles applies to all examined claims currently pending.

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<sup>12</sup> See also MPEP §2113.

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### *Conclusion*

32. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure includes the following: Howard et. al. (U.S. 6,513,017 B1); Porter (U.S. 6,426,699 B1); Kenney (U.S. 6,381,583 B1); Burke (U.S. 6,304,855 B1); Allard et. al. (U.S. 6,249,773 B1); Matsumori (U.S. 6,246,998 B1); Lake et. al. (U.S. 6,155,715); Burke (U.S. 6,026,377); Kenney (U.S. 6,026,376); Burke (U.S. 5,848,399); Mogil et. al. (U.S. D 328,550); Sparks (U.S. 4,037,853); Fullington et. al. (U.S. 3,628,807); Thompson (U.S. 3,237,721); Farls (U.S. 2,710,639); Green (U.S. 2,310,627); Onstott (U.S. 2,301,639); Bingham (U.S. 2,128,689); Williams (U.S. 1,034,050); Steinman (U.S. 934,230); Stinson (U.S. 795,560); Kimber (U.S. 338,846); and Brosius (U.S. 76,297).

33. Suggestions or examples of claim language provided by the Examiner in this Office Action are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that the claim is “allowed,” exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1<sup>st</sup> paragraph written description and enablement, §112 2<sup>nd</sup> paragraph antecedent basis and indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment that incorporates an Examiner suggestion or example or simply changes claim interpretation will still require further consideration and/or search and a patentability determination as described above.

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34. In accordance with *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner cites How Computers Work Millennium Ed. by Ron White; How Networks Work, Millennium Ed. by Frank J. Derfler et. al.; and How the Internet Works, Millennium Ed. by Preston Gralla as additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Each reference is cited in its entirety. Since the references are directed towards beginners, the references are primarily directed towards those of *low* skill in the art. Therefore, one of *ordinary* skill in the art must—at the very least—be aware of the knowledge contained within the references.


35. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has provided Applicant(s) with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. If Applicant disagrees with *any* factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,<sup>13</sup> the Examiner respectfully reminds Applicant to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) *in their next response*. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal

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<sup>13</sup> E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.

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towards allowance in the shortest possible time. If Applicant has any questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292.

 7/11/03  
Andrew J. Fischer  
Patent Examiner

AJF  
July 11, 2003